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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/618,867

07/14/2003

Gary E. Sullivan

P1544US01

6958

32709

7590

07/03/2006

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EXAMINER

TRAN, TRANG U

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,867

Applicant(s)

SULLIVAN ET AL.

Examiner

Trang U. Tran

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-36 is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/11/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 14, 16, 27-28 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 10-12 of U.S. Patent No. 6,593,973. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 14, 16, 27-28 and 31 of this application are broader than and encompass claims 1-2 and 10-12 of U.S. Patent No. 6,593,973. Therefore, the obviousness-type double patenting is applied.

Regarding claim 1, claims 1 and 11 of U.S. Patent No. 6,593,973 recited all the limitations of claim 1 of this application. It is noted that claim 1 of this application are

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broader than and encompass claims 1 and 11 of U.S. Patent No. 6,593,973. Therefore, the obviousness-type double patenting is applied.

Regarding claim 14, claims 1 and 12 of U.S. Patent No. 6,593,973 recited all the limitations of claim 14 of this application. It is noted that claim 14 of this application are broader than and encompass claims 1 and 12 of U.S. Patent No. 6,593,973. Therefore, the obviousness-type double patenting is applied.

Regarding claim 16, claim 1 and 12 of U.S. Patent No. 6,593,973 recited all the limitations of claim 16 of this application.

Regarding claim 27, claims 1 and 2 of U.S. Patent No. 6,593,973 recited all the limitations of claim 27 of this application. It is noted that claim 27 of this application are broader than and encompass claims 1 and 2 of U.S. Patent No. 6,593,973. Therefore, the obviousness-type double patenting is applied.

Regarding claim 28, claims 1 and 2 of U.S. Patent No. 6,593,973 recited all the limitations of claim 28 of this application.

Regarding claim 31, claims 1 and 10 of U.S. Patent No. 6,593,973 recited all the limitations of claim 31 of this application. It is noted that claim 31 of this application are broader than and encompass claims 1 and 10 of U.S. Patent No. 6,593,973. Therefore, the obviousness-type double patenting is applied.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-4, 6-7, 10-14, 16-17, 19-20, 23-26 and 17 are rejected under 35

U.S.C. 102(b) as being anticipated by Goode et al (US. Patent No. 5,781,227).

In consider claim 1, Goode et al discloses all the claimed subject matter, note 1) the claimed means for providing an output to a display in response to an input signal received from a video source, said output providing means including means for buffering the input signal is met by the set top terminal 108 which receives the video program stream via a forward channel, processes the decompressed information for display upon the display unit 110 (Fig. 1, col. 4, lines 5-33), 2) the claimed means for decoding an encoded video signal into a decoded video signal is met by the decoder 130 (Fig. 1, col. 4, lines 34-56), 3) the claimed means, coupled to said output providing means, for overlaying the decoded video signal decoded by said decoding means onto the display during a transition when said output providing means switches from a first video source to a second video source is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19), and 4) the claimed wherein said apparatus comprises a plurality of encoded video signals, said apparatus being capable of selecting a specific encoded video signal for decoding and display during the transition based upon said encoded video signal's relevance to either a content's subject matter displayed by the first video source prior to the transition or a content's subject matter

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selected for display via the second video source following the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 4, line 34 to col. 5, line 63).

In consider claim 3, the claimed said decoding means comprising a decoder compliant with an MPEG standard is met by the MPEG decoder 103 (Fig. 1, col. 4, lines 5-56).

In consider claim 4, the claimed said overlaying means comprising a video overlay is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

In consider claim 6, the claimed said decoding means being capable of receiving the coded video signal via a network is met by the communications network 106 (Fig. 1, col. 3, lines 1-60).

In consider claim 7, the claimed further comprising an alternate means for decoding an encoded video signal into a decoded video signal wherein said overlaying means overlays the decoded video signal of said alternate decoding means during the transition when said decoding means is unavailable during the transition is met by the display of such function information is generally handled by recalling a particular bit map

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image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

In consider claim 10, the claimed further comprising means for storing an encoded signal such that the encoded signal is available to be decoded by said decoding means upon an occurrence of the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 4, line 34 to col. 5, line 63).

In consider claim 11, the claimed further comprising a memory capable of storing an encoded signal such that the encoded signal is available to be decoded by said decoding means upon an occurrence of the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 4, line 34 to col. 5, line 63).

In consider claim 12, the claimed further comprising a processor for executing a program of instructions that controls the apparatus, said processor being coupled to said output providing means via a bus is met by the CPU 122 (Fig. 1 and 2, col. 4, line 34 to col. 6, line 30).

In consider claim 13, the claimed wherein said apparatus is capable of extending the transition to a predetermined time duration when said output providing means switches from the first video source to the second video source, thereby ensuring that

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the decoded video signal is capable of being displayed in its entirety is met by the setting a transition timer within the decoder (Fig. 2, col. 5, line 21 to col. 6, line 30).

In consider claim 14, Goode et al discloses all the claimed subject matter, note 1) the claimed means for providing an output to a display in response to an input signal received from a video source, said output providing means including means for buffering the input signal is met by the set top terminal 108 which receives the video program stream via a forward channel, processes the decompressed information for display upon the display unit 110 (Fig. 1, col. 4, lines 5-33), 2) the claimed means for decoding an encoded video signal into a decoded video signal is met by the decoder 130 (Fig. 1, col. 4, lines 34-56), and 3) the claimed means, coupled to said output providing means, for overlaying the decoded video signal decoded by said decoding means onto the display during a transition when said output providing means switches from a first video source to a second video source is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19), and 4) the claimed wherein said apparatus is capable of extending the transition to a predetermined time duration when said output providing means switches from the first video source to the second video source, thereby ensuring that the decoded video signal is capable of being displayed in its entirety is met by the setting a transition timer within the decoder (Fig. 2, col. 5, line 21 to col. 6, line 30).

Claims 16-17 are rejected for the same reason as discussed in claims 3-4, respectively.

Claims 19-20 are rejected for the same reason as discussed in claims 6-7, respectively.

Claims 23-25 are rejected for the same reason as discussed in claims 10-12, respectively.

Claim 26 is rejected for the same reason as discussed in claim 1.

In consider claim 31, Goode et al discloses all the claimed subject matter, note 1) the claimed means for providing an output to a display in response to an input signal received from a video source, said output providing means including means for buffering the input signal is met by the set top terminal 108 which receives the video program stream via a forward channel, processes the decompressed information for display upon the display unit 110 (Fig. 1, col. 4, lines 5-33), 2) the claimed means for decoding an encoded video signal into a decoded video signal is met by the decoder 130 (Fig. 1, col. 4, lines 34-56), and 3) the claimed means, coupled to said output providing means, for overlaying the decoded video signal decoded by said decoding means onto the display during a transition when said output providing means switches from a first video source to a second video source is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5, 8-9, 15, 18, 21-22 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (US Patent No. 5,781,227) in view of Jernigan et al (US Patent No. 5,233,423).

In considering claim 2, Goode et al discloses all the claimed subject matter, note 1) the claimed said buffering means comprising video memory is met by the image memory 128 (Fig. 1, col. 4, lines 34-56). However, Goode et al explicitly do not disclose the claimed said output providing means comprising a graphics controller. Jernigan et al teach that a graphics and memory controller 20 is coupled to the micro-controller 16 and the ROM 12 for addressing the ROM 12 under control of the micro-controller 16 and for generating the appropriate graphic images representative of the data being addressed in ROM 12, the output from the graphics and memory controller 20 is applied to a pallet controller 22 (in the event of color) via the data bus 14 which generates the RGB video signal for the particular advertisement (col. 2, lines 35-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a graphics controller as taught by Jernigan et al into Goode et al's system in order to providing the source of image video signal for displayed.

In considering claim 5, Goode et al discloses all the claimed subject matter, note 1) the claimed said buffering means comprising video memory, said decoding means comprising a decoder compliant with an MPEG standard, and said overlaying means comprising a video overlay is met by the image memory 128 and the MPEG decoder 103 (Fig. 1, col. 3, line 54 to col. 4, line 56). However, Goode et al explicitly do not disclose the claimed said output providing means comprising a graphics controller. Jernigan et al teach that a graphics and memory controller 20 is coupled to the micro-controller 16 and the ROM 12 for addressing the ROM 12 under control of the micro-controller 16 and for generating the appropriate graphic images representative of the data being addressed in ROM 12, the output from the graphics and memory controller 20 is applied to a pallet controller 22 (in the event of color) via the data bus 14 which generates the RGB video signal for the particular advertisement (col. 2, lines 35-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a graphics controller as taught by Jernigan et al into Goode et al's system in order to providing the source of image video signal for displayed.

In considering claim 8, Goode et al disclose all the limitations of the instant invention as discussed in claim 1 above, except for providing the claimed said decoding means being capable of decoding an encoded commercial video signal into a decoded commercial video signal such that said overlaying means overlays the decoded commercial video signal during the transition. Jernigan et al teach that in particular, the method comprises locally storing in said television receiver data representing commercial advertisements, selectively converting said data into video signals, and

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selectively switching said video signals to the display of said television receiver for a predetermined period of time (col. 1, lines 33 to col. 2, line 68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the display commercial advertisement as taught by Jernigan et al into Goode et al's system in order to deliver commercial advertisement to the consumer at a significantly lower cost to the advertiser.

In considering claim 9, Goode et al disclose all the limitations of the instant invention as discussed in claim 1 above, except for providing the claimed said decoding means being capable of decoding a video signal containing advertisement information into a decoded commercial video signal containing advertisement information such that said overlaying means overlays the decoded video signal containing advertisement information during the transition. Jernigan et al teach that in particular, the method comprises locally storing in said television receiver data representing commercial advertisements, selectively converting said data into video signals, and selectively switching said video signals to the display of said television receiver for a predetermined period of time (col. 1, lines 33 to col. 2, line 68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the display commercial advertisement as taught by Jernigan et al into Goode et al's system in order to deliver commercial advertisement to the consumer at a significantly lower cost to the advertiser.

Claim 15 is rejected for the same reason as discussed in claim 2.

Claim 18 is rejected for the same reason as discussed in claim 5.

Claims 21-22 are rejected for the same reason as discussed in claims 8-9, respectively.

In considering claim 27, Goode et al discloses all the claimed subject matter, note 1) the claimed means for providing an output to a display in response to an input signal received from a video source, said output providing means including means for buffering the input signal, and said buffering means comprising video memory is met by the set top terminal 108 which receives the video program stream via a forward channel, processes the decompressed information for display upon the display unit 110 and the memory 128 (Fig. 1, col. 4, lines 5-33), 2) the claimed means for decoding an encoded video signal into a decoded video signal is met by the decoder 130 (Fig. 1, col. 4, lines 34-56), and 3) the claimed means, coupled to said output providing means, for overlaying the decoded video signal decoded by said decoding means onto the display during a transition when said output providing means switches from a first video source to a second video source is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

However, Goode et al explicitly do not disclose the claimed said output providing means comprising a graphics controller.

Jernigan et al teach that a graphics and memory controller 20 is coupled to the micro-controller 16 and the ROM 12 for addressing the ROM 12 under control of the

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micro-controller 16 and for generating the appropriate graphic images representative of the data being addressed in ROM 12, the output from the graphics and memory controller 20 is applied to a pallet controller 22 (in the event of color) via the data bus 14 which generates the RGB video signal for the particular advertisement (col. 2, lines 35-68).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a graphics controller as taught by Jernigan et al into Goode et al's system in order to providing the source of image video signal for displayed.

In consider claim 28, the claimed said decoding means comprising a decoder compliant with an MPEG standard is met by the MPEG decoder 103 (Fig. 1, col. 4, lines 5-56 of Goode et al).

In consider claim 29, the claimed said overlaying means comprising a video overlay is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19 of Goode et al).

In considering claim 30, the claimed said decoding means comprising a decoder compliant with an MPEG standard, and said overlaying means comprising a video overlay, wherein video data from the video overlay is provided to the display through the

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graphics controller is met by the image memory 128 and the MPEG decoder 103 (Fig. 1, col. 3, line 54 to col. 4, line 56 of Goode et al)

Allowable Subject Matter

7. Claims 32-36 are allowed.

The independent claim 32 identifies the distinct feature: “detecting an a occurrence of the transition from a first video source to a second video source; if an occurrence of a video transition from a first video source to a second video source is detected, then determining if a first decoder is available; and if the first decoder is not available, then selecting a second decoder”. The prior arts, Goode et al (US Patent No. 5,781,227) and Jernigan et al (US Patent No. 5,233,423), either singularly or in combination, fail to anticipate or render the above underlined limitations obvious.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grossman et al (US. Patent No. 5,907,321) discloses method for transmitting and displaying an interchannel interval image in a cable system.

Fuller (US. Patent No. 5,818,512) disclose video distribution system.

Ogura et al (US. Patent No. 5,311,317) disclose video signal processing apparatus for displaying stored video signal during channel selection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang U. Tran whose telephone number is (571) 272-7358. The examiner can normally be reached on 8:00 AM - 5:30 PM, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT
June 22, 2006



Trang U. Tran
Examiner
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